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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/424,544	11/24/1999	MASUMITSU INO	SON-1582/SUG	8128

7590 08/24/2006

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EXAMINER

PIZIALI, JEFFREY J

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 08/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Interview Summary	Application No. 09/424,544	Applicant(s) INO ET AL.	
	Examiner Jeff Piziali	Art Unit 2629	

All participants (applicant, applicant's representative, PTO personnel):

(1) Jeff Piziali. (3) _____.

(2) Brian Dutton (Registration Number 47,255). (4) _____.

Date of Interview: 16 August 2006.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: _____.

Claim(s) discussed: 3, 5-7, 11, 13-20, 23-29, 31, 37, and 43-48.

Identification of prior art discussed: indirectly, Takeda et al (US 4,825,203).


Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation Sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required 8/16/06

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case. It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

Continuation of Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments:

The appellants' representative, Mr. Brian Dutton (Registration Number 47,255) phoned to lodge a complaint over the propriety of the 'Notification of Non-Compliant Appeal Brief (37 CFR 41.37)' mailed 21 July 2006, as well as to seek clarification of the grounds of non-compliance.

The examiner explained that the Appeal Brief filed 13 December 2005 is non-compliant, because the Appeal Brief fails to include a statement of the established "objected to" status of claims 13 and 14 (see Page 2 of the 'Supplemental Appellant's Brief' filed 13 December 2005, as well as Page 3 of the Office Action mailed 4 November 2003); the Appeal Brief fails to include an identification of any claims that are being appealed (see Pages 2-3 of the 'Supplemental Appellant's Brief' filed 13 December 2005); and because the Appeal Brief fails to include a statement setting forth where in the record that alleged evidence (such as U.S. Patent No. 6,788,380 to Melnik et al.; Verdegaal Bros., Inc. v. Union Oil Co.; and Trintec Indus., Inc. v. Top-U.S.A. Corp.) was entered in the record by the examiner (see Page 26 of the 'Supplemental Appellant's Brief' filed 13 December 2005).

Mr. Dutton expressed intent to add a statement that certain claims are "objected to" in the next Appeal Brief -- a statement he admitted was missing from the current brief. Mr. Dutton also expressed intent to remove all reference to the three aforementioned pieces of evidence from the next Appeal Brief -- evidence he admitted was unentered by the examiner at any point during prosecution, and that he was now seeking to use to prop up his arguments in the current brief.

When questioned why he chose to remove the required statement identifying the precise claims under appeal (a statement which was present on page 4 of the immediate previous Appeal Brief filed 29 October 2004), Mr. Dutton admitted having made a mistake and apologized for neglecting to include this explicit identification of the appealed claims. In light of Mr. Dutton's express acknowledgement of his own mistake, the examiner asked if Mr. Dutton still took issue with the appropriateness of the 'Notification of Non-Compliant Appeal Brief (37 CFR 41.37)' mailed 21 July 2006. At this point, Mr. Dutton denied having ever admitted his mistake, and refused to further explain why he had just moments earlier apologized.

Considering he called in part to complain, Mr. Dutton was asked if he could cite any errors made by the examiner in the 'Notification of Non-Compliant Appeal Brief (37 CFR 41.37)' mailed 21 July 2006. Mr. Dutton accused the examiner of "an abuse of power," but was unable to identify any explicit errors in the 'Notification of Non-Compliant Appeal Brief (37 CFR 41.37)' mailed 21 July 2006.

Over the course of the past two years, Mr. Dutton has submitted four consecutive and incontrovertibly non-compliant Appeal Briefs. During this time span, USPTO Directors, Quality Assurance Specialists, Special Program Examiners, and Supervisors have examined, analyzed, and evaluated every Notice of Non-Compliance composed and mailed by this examiner. No errors have been discovered in this examiner's work.

Regardless, Mr. Dutton remains convinced the examiner is wholly at fault for his string of non-compliant Appeal Briefs.

MPEP § 1205.03 clearly states, "The appeal will be dismissed if the appellant does not timely file an amended brief, or files an amended brief which does not overcome all the reasons for noncompliance of which the appellant was notified."

By all rightful USPTO policies and practices, as a result of Mr. Dutton's series of egregiously non-compliant Appeal Briefs, the examiner has had three distinct and legitimate opportunities to officially abandon the instant application. As a courtesy to the appellants, the examiner has not yet done so. Accordingly, the examiner respectfully disagrees with Mr. Dutton's discourteous accusation of "an abuse of power."

At the conclusion of the interview, Mr. Dutton thanked the examiner for the provided clarifications of the rules under 37 CFR 41.37, and expressed intent to submit yet another Appeal Brief.



Jeff Piziali

16 August 2006